

REMARKS

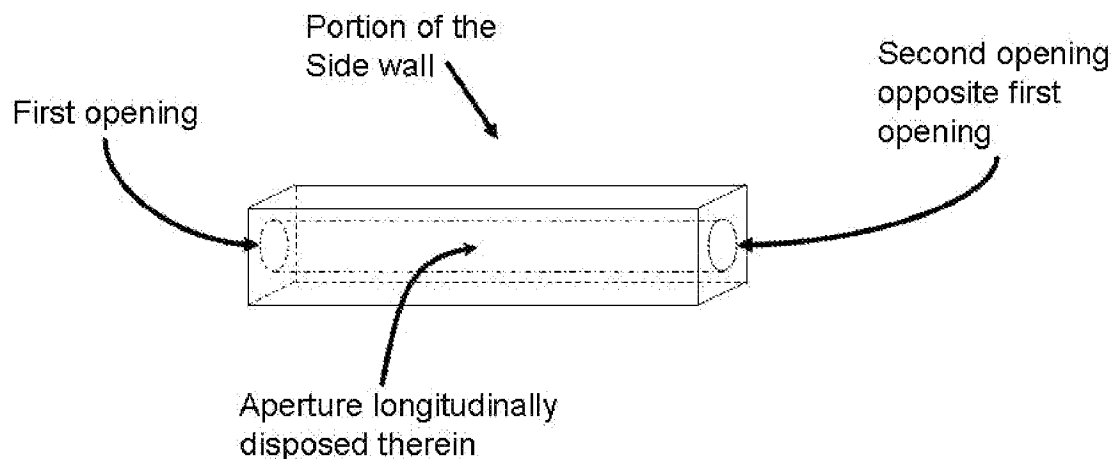
Claims 1-45, 47 and 49-60 are pending. Claims 1-34, 37-45 and 51-60 were withdrawn from consideration. Claims 35, 36, 47, 49 and 50 were rejected. By virtue of this response, claim 35 has been amended. Accordingly, claims 35, 36, 47, 49, and 50 are currently under consideration. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented.

Claim Rejections under 35 USC §112

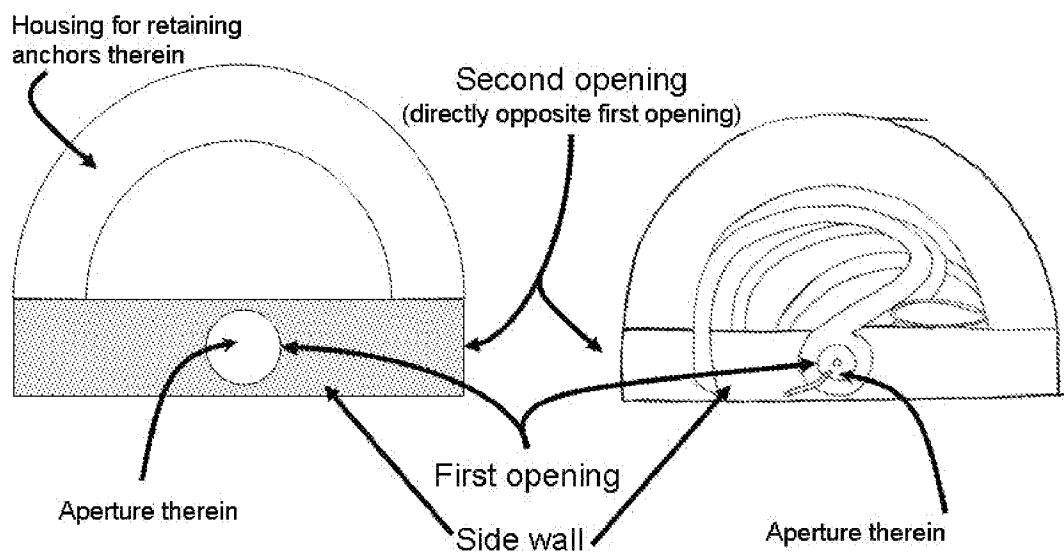
Claims 35, 36, 47, 49, and 50

Claims 35, 36, 47, 49, and 50 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Office Action alleges that there is insufficient support in the disclosure for an “aperture having a first opening and a second opening” in lines 7-8 of claim 35. Applicant disagrees with this rejection.

As amended, claim 35 describes a side wall that has at least one aperture “disposed longitudinally therein the aperture having a first opening and a second opening opposite the first opening.” An aperture inherently has two openings, including an aperture *longitudinally* disposed within a side wall, as shown in the conceptual drawing below.



The first opening exists at one end of the aperture, and the second opening exists at the opposite end of the aperture. The longitudinal aperture with a first and second opening is depicted in several figures in the disclosure, for example, Figs. 5A-5B, 7, and 8. Fig. 7 (which is a front view of the device) is reproduced and annotated below, along with the side wall from the above conceptual drawing for reference.



As described above, the inherent second opening is located opposite to the first opening, i.e. if the first opening is on the distal end of the aperture, then the second opening is proximal to it. To further clarify the inherent openings, claim 35 has been amended to explicitly recite that the second opening is opposite the first opening. Figs. 5A-5B, 7, and 8 depict the inherent first and second openings of the aperture in such a way as to reasonably convey to one skilled in the art that the inventor, at the time the application was filed, had possession of the explicit and inherent subject matter described in claim 35.

The Office Action also alleges that there is insufficient support in the disclosure for the limitation that when “the device is in the second configuration the mandrel is at least partially withdrawn from the aperture to release the at least one tethered anchor from the housing body,” and

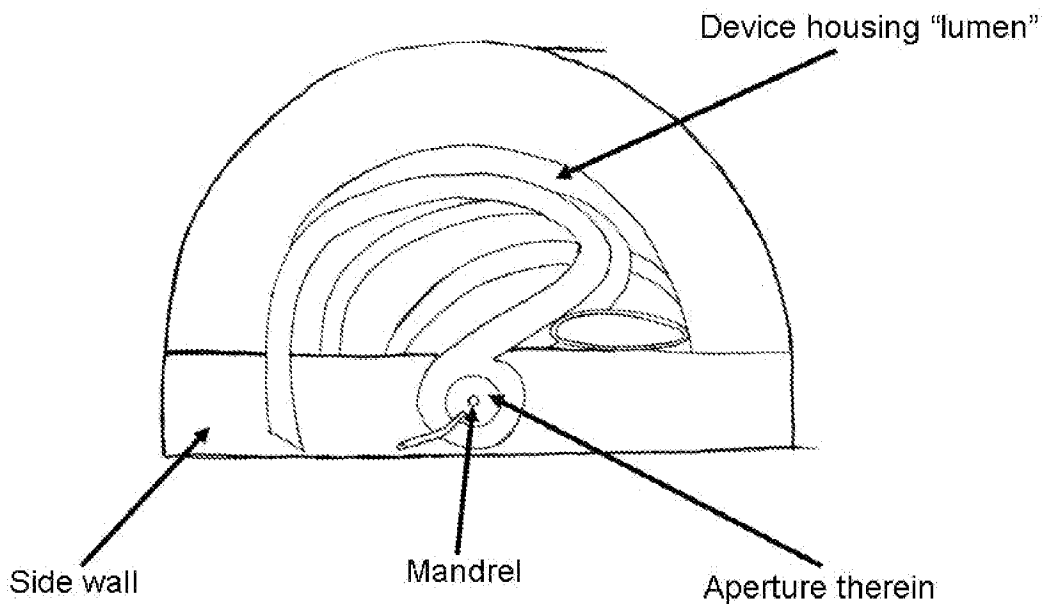
notes that the specification provides support for withdrawing the mandrel along with the housing, but not independently of the housing. Applicant disagrees with this allegation. The specification clearly states in ¶0054 that “Hooks 232 may be coupled to the device via a pivot mandrel 236.” This indicates that in the *absence* of the mandrel (but in the *presence* of the device housing), the hooks would be uncoupled from the device. However, to expedite prosecution, Applicant has amended claim 35 to recite that “when the device is in the second configuration the mandrel is withdrawn to release the at least one tethered anchor from the housing body.” Written description support for this amendment may be found in ¶0054. Since the mandrel acts to couple the anchor to the housing body of the device, withdrawing the mandrel (regardless of whether the mandrel is withdrawn independently of the device or not) will decouple the anchor from the device. As clarified above, the limitations in claim 35 are sufficiently described in the specification to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. For at least these reasons, a rejection of claims 35, 36, 47, 49, and 50 under 35 U.S.C. §112, paragraph 1, cannot stand.

Claims 35, 36, 47, 49, and 50

Claims 35, 36, 47, 49, and 50 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Office Action alleges that it is unclear how a single aperture may comprise two openings, and furthermore, asserts that the aperture may be construed as either an opening in the side wall or the housing lumen. Applicant strongly disagrees with this rejection.

First, as clarified previously and depicted above, every aperture inherently has two openings. Second, the aperture described in claim 35 is referring to an opening longitudinally disposed within the side wall of the housing, and cannot be reasonably construed to be the housing lumen. Claim 35 clearly distinguishes the housing body lumen from the aperture disposed longitudinally in the housing body sidewall. Specifically, the claim recites that the housing body

retains at least one tethered anchor, while the aperture disposed longitudinally in the side wall of the housing body retains a mandrel. As described, it is evident that the portion of the housing body that retains the anchor is distinct from the aperture in the side wall that retains the mandrel. The claim also specifies that when the mandrel is withdrawn, the at least one tethered anchor is released from the *housing body* (not the aperture). The mandrel retained in the longitudinal *aperture* disposed in the side wall controls the release of the tethered anchor from the *housing body*. As distinctly described in claim 35, the aperture longitudinally disposed in the side wall cannot be interpreted in any way to be the lumen of the housing body. Additionally, the description provided in Applicant's specification further clarifies the distinction between the longitudinal aperture in the side wall of the housing, and the lumen of the housing body. To be sure, the mandrel is not in the lumen of the housing, but is in the longitudinal aperture in the side wall, as shown particularly clearly in Fig. 7 (which is reproduced and annotated below).



As explained here and depicted in the specification, independent claim 35 particularly points out and distinctly claims the subject matter which is sought to be protected, and a rejection of claims 35, 36, 47, 49, and 50 under 35 U.S.C. §112, paragraph 2, cannot stand.

Claim Rejections under 35 USC §102

Claims 35, 36, 47, 49, and 50

Claims 35, 36, 47, 49, and 50 stand rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Pat. No. 7,004,958 to Adams et al. (“Adams”). The Office Action states that Adams discloses a device comprising an elongate body with a housing at the distal end thereof, the housing comprising a side wall spanning a longitudinal length thereof, wherein the side wall has at least one aperture disposed longitudinally therein. The Office Action further asserts that the aperture has a first opening and second opening, and that when the device is in a first configuration, the aperture retains a mandrel therein, and when the device is in a second configuration, the mandrel is at least partially withdrawn from the aperture to release the at least one tethered anchor from the housing body. Applicant strongly disagrees with this rejection.

Adams fails to disclose each and every element of independent claim 35, from which all currently rejected claims depend. For example, claim 35 requires that the aperture comprise three elements. First, the aperture of claim 35 must be disposed longitudinally in the side wall (“side wall has at least one aperture disposed longitudinally **therein**”). Second, the aperture must have a first and second opening, the second opening opposite the first. Third, the aperture must retain a mandrel (“the aperture retains a mandrel **therein**”). The lumen of the Adams device housing fails to satisfy all three requirements, since it is not disposed longitudinally **in** a side wall. Instead it defines the side walls. Furthermore, the interpretation set forth by the Office Action that the aperture in the Adams device is the lumen of the housing, the first opening is the slit, and the second opening is the distal end of the housing fails to satisfy the requirement that the second opening is opposite the first. The slit of the Adams device also fails to satisfy all three requirements, since it does not retain a mandrel therein, and is in fact incapable of retaining a mandrel therein. The slit is a break-away slot that prevents the staples of Adams from being released prior to being forced out of the catheter, and plays no role in retaining tool 50 (which the Office Action refers to as the “mandrel”). Furthermore, the slit is not disposed *longitudinally in* the side wall; if anything, it is disposed *laterally along* the

side wall. Applicant further points out that the instant claims also positively recite the at least one tethered anchor and the mandrel as components of the device. The tethered anchor is retained in the housing body, and the mandrel is retained in the aperture longitudinally disposed in the side wall. Adams fails to disclose a device comprising a tethered anchor retained in a housing body and also fails to disclose that the device comprises a mandrel retained in an aperture longitudinally disposed in a sidewall. Since Adams fails to disclose each and every limitation of independent claim 35, a rejection of claims 35, 36, 47, 49, and 50 under 35 U.S.C. §102(e) cannot stand. Applicant submits that the pending claims are in condition for allowance.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

Any remarks in support of patentability of one claim should not be imputed to any other claim, even if similar terminology is used. Additionally, any remarks referring to only a portion of a claim should not be understood to base patentability on that portion; rather, patentability must rest on each claim taken as a whole. Applicant respectfully traverses each of the Examiner's rejections and each of the Examiner's assertions regarding what the prior art shows or teaches, even if not expressly discussed herein. Although amendments have been made, no acquiescence or estoppel is or should be implied thereby. Rather, the amendments are made only to expedite prosecution of the present application, and without prejudice to presentation or assertion, in the future, of claims on the subject matter affected thereby.

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child, or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 578492001500.

However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: May 11, 2009

Respectfully submitted,

By Electronic Signature: /Walter Wu/
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